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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,174	08/20/2003	Susan Crawford Pope	65448 84753	5715

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EXAMINER

NGUYEN, SON T

ART UNIT PAPER NUMBER

3643

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,174

Applicant(s)

POPE, SUSAN CRAWFORD

Examiner

Son T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/8/05 & 5/9/05.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-22 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-9,13-16,18-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohamed (US 5287Mohamed) in view of Fain (US 6192Fain).

For claims 1-3,6, Mohamed discloses an article useful for attracting canines and for inducing the canines to eliminate in a vicinity where the article is placed, the article comprising a polymeric body (col. 6, lines 1-8) with a canine attractant material that further comprises an active ingredient capable of inducing the canine to eliminate (throughout patent, esp. col. 5, line 68 and col. 6, lines 1-8). However, Mohamed is silent about the specific body with at least one surface or cavity and the article is a lawn stake with cap and stake portions, and the active ingredient being p-cresyl acetate and phenyl acetic acid.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ p-cresyl acetate and/or phenyl acetic acid as the preferred active ingredient in the article of Mohamed, since it has been held to be within the general skill of a worker in the art to select a known chemical on the basis of its suitability for the intended use, to make the composition more potent, as a matter of obvious choice. In re Leshin, 125 USPQ 416.

Fain teaches a lawn stake with a body 50 having a cavity 78, cap 60 and stake 54 portions, the body holds an attractant 76 in the cavity of the stake to attract desired animals (col. 1, line 55, col. 3, lines 53-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a stake article with a body with a cavity, cap and stake portions as taught by Fain as the preferred polymeric article of Mohamed in order to contain the attractant material and to allow the article to be inserted into the ground.

For claims 4 & 5, in addition to the above, Mohamed as modified by Fain (emphasis on Mohamed) teaches that the polymeric body, in this case, the stake, be coated or impregnated with the attractant material (col. 5, line 68 and col. 6, lines 1-8).

For claim 7, Mohamed as modified by Fain (emphasis on Fain) teaches a cover 60 over the cavity.

For claim 8, Mohamed as modified by Fain (emphasis on Fain) teaches the cover 60 being connected to the body by cap posts 74 instead of a hinge. It would have been an obvious substitution of functional equivalent to substitute the cap posts of Mohamed as modified by Fain (emphasis on Fain) with a hinge, since both types of connecting member would perform to allow the cover to be removable.

For claim 9, Mohamed as modified by Fain (emphasis on Fain) teaches the cavity is vented through the top opening of the body.

For claim 13, Mohamed as modified by Fain (emphasis on Mohamed) teaches the attractant material coating or impregnating the polymeric body (col. 5, line 68 and col. 6, lines 1-8), thus making the material a coating.

For claims 14-16, Mohamed as modified by Fain (emphasis on Fain) teaches the body being injection molded (col. 5, line 11) into one unit together forming the stake.

For claim 18, it would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the article of Mohamed as modified by Fain out of thermoplastics, fiberglass or nylon, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice.

For claims 19-21, Mohamed as modified by Fain (emphasis on Fain) teaches the body is attachable to a support surface such as the ground or a window sill, which is the substantially flat surface, by using plate 77 with nail holes 79 (col. 5, lines 48-50).

3. **Claims 10-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohamed as modified by Fain as applied to claim 1 above, and further in view of Reichert (US 6531Reichert).

Reichert teaches an attractant material for training dogs, the material comprises solids which include active ingredient to entice the dogs. The solids are microspheres or microporous beads 12. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ solids in microspheres which include active ingredient to entice the dogs as taught by Reichert as the attractant material in the article of Mohamed as modified by Fain in order to provide easier handling since the attractant material is in solid form.

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4. **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Mohamed as modified by Fain and Reichert. See the above explanation, for the limitation is the same as explained by Mohamed, Fain and Reichert.

Response to Arguments

5. Applicant's arguments filed 5/9/05 have been fully considered but they are not persuasive.

The Declaration of Susan Knox has been acknowledged but is not found to be persuasive.

MPEP 716.03 [R-2] states that:

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In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

In *ex parte* proceedings before the Patent and Trademark Office, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Compare *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) (In civil litigation, a patentee does not have to prove that the commercial success is not due to other factors. "A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence.").

See also *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product); *In re Fielder*, 471 F.2d 690, 176 USPQ 300 (CCPA 1973) (success of invention could be due to recent changes in related technology or consumer demand; here success of claimed voting ballot could be due to the contemporary drive toward greater use of automated data processing techniques); *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985) (evidence of licensing is a secondary consideration which must be carefully appraised as to its evidentiary value because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986) (Evidence of commercial success supported a conclusion of nonobviousness of claims to an immunometric "sandwich" assay with monoclonal antibodies. Patentee's assays became a market leader with 25% of the market within a few years. Evidence of advertising did not show absence of a nexus between commercial success and the merits of the claimed invention because spending 25-35% of sales on marketing was not inordinate (mature companies spent 17-32% of sales in this market), and advertising served primarily to make industry aware of the product because this is not kind of merchandise that can be sold by advertising hyperbole.).

Applicant has not provided such evidence as required for commercial success to overcome the obviousness rejection. PetsMart is a big pet product company, therefore, the company is a market leader and can provide extensive advertising which may influence consumers to purchase the yard stake. Applicant must provide evidence that this is not the case in Applicant's commercial success of the yard stake.

Applicant argued that Mohamed nor any prior art mentions a yard stake.

Mohamed states that his invention can be molded into article such as a dish to make cleanup easier and enhance portability of the device (col. 6, lines 5-8). Clearly, Mohamed is not only limited to a dish but other molded articles as long as the article can present itself to portability. Fain teaches a stake with similar features as the present invention and the stake is a molded article to hold an attractant, whether for insect or other animal, it would be functional of the device and intended usage as long as the scope of the invention is not altered (meaning the device still attracts animals). Therefore, one of ordinary skill in the art would relied on Fain for a molded article and employ the invention of Mohamed therein to attract animals because Mohamed states that his invention can be in molded article. In addition, animal attractants are notoriously well known to be placed in a stake-like article, see patents 6241161 & 5914119. This is not a new concept in the art to place attractant in stake-like article for portability and convenient.

Applicant's main argument is that none of the prior arts, especially Mohamed, teach p-cresyl acetate and phenyl acetic acid as the preferred active ingredient in the article for attracting canines.

Mohamed teaches an article for attracting canines comprising a polymeric body (col. 6, lines 1-8) having an active ingredient that can be chosen from a list of chemical based on the desired choice of the user. Since Mohamed states that his invention can be molded or employed as some sort of polymeric body to attract a canine, Fain is relied upon for this polymeric body because Mohamed lists various body that can be used in col. 6, lines 1-8. Therefore, the combination of Mohamed as modified by Fain teaches the present invention except for the specific active ingredient of p-cresyl acetate and phenyl acetic acid.

As stated by Applicant, these ingredients are known to be used for flavoring or perfume, which are both considered to be attractants to animal. Therefore, to choose an ingredient that has already been invented would be obvious to one of ordinary skill in the art to make the article more potent because some ingredients may or may not be more potent than others. Conducting experimentation on already known and invented ingredients would be routine based on general testing procedure to find the best result for the composition desired. Applicant did not find anything new, regarding the property or characteristic of p-cresyl acetate and phenyl acetic acid, thus, to pick an ingredient that is already known for its flavoring and perfumery characteristics would just merely be obvious to one of ordinary skill in the art based on routine testing and experimentation for a more potent composition.

It is to the Examiner's opinion that Applicant did not find unexpected result by employ p-cresyl acetate and phenyl acetic acid because when employing these two ingredients, they still have the same characteristics as when they are invented, and that

is for attracting an animal by flavoring or perfumery. Nothing new has been found about these two ingredients, therefore, it cannot be unexpected result. Page 9 of Applicant's specification states that it is preferred to use p-cresyl acetate and phenyl acetic acid but gives no critical reason why p-cresyl acetate and phenyl acetic acid are necessary to produce some sort of unexpected result in the animal's reaction to the chemicals.

Applicant argued that the Examiner is hindsighting into Applicant's own invention.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argued that while the examiner may personally disagree, and may subjectively believe the scent selection process to be "obvious" or "routine," applicant respectfully submits that the examiner's opinion alone is not basis enough to reach the conclusion that the recited invention is obvious in the face of sworn testimony to the contrary by those who are grounded in the very industry to which the invention pertains. Even if it is determined that a prima facie case of

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obviousness is established, the evidence of secondary considerations of non-obviousness is sufficiently persuasive to overcome the rejections.

Applicant has not provided evidence that scent selection of p-cresyl acetate and phenyl acetic acid produce unexpected result, therefore, it is concluded that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use p-cresyl acetate and phenyl acetic acid, since it has been held to be within the general skill of a worker in the art to select a known chemical on the basis of its suitability for the intended use, to make the composition more potent, as a matter of obvious choice. In re Leshin, 125 USPQ 416. This is not the Examiner's own opinion but also the decision of Applicant because page 9 of Applicant's specification only state that p-cresyl acetate and phenyl acetic acid are preferred but gives no critical reason why, thus, it is considered as merely choosing known chemicals on the basis of Applicant's own intended use to make the composition more potent.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Son T. Nguyen
Primary Examiner
Art Unit 3643

stn